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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,843

11/15/2003

Isaac D. Cohen

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EXAMINER

HUI, SAN MING R

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

07/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/713,843	COHEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	San-ming Hui	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/17/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1-24 are pending.

Claims 8-9 and 15-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 24, 2007.

The outstanding rejection under 35 USC 103(a) is withdrawn in view of the amendments filed September 10, 2008 as the claims are directed to a specific particle size that the pigment is have a larger particle size than that of the glass beads.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,242,056 ('056) and EP 1 013 724 ('724).

'056 teaches a paint composition containing glass beads and a colorants such as alumina (See the abstract). '056 also teaches the particle size of glass beads as 10-20 microns (See col. 2, line 28 for example). '056 teaches the glass beads can be clear and have light refractive value of 1.5-2.5 (See col. 3, line 64).

'724 teaches a pigment mixtures comprising titanium oxide coated alumina ( $\text{Al}_2\text{O}_3$ ) and bismuth oxychloride ( $\text{BiOCl}$ ) (See paragraph [0019]) with improved hiding power (see paragraph [0002]). '724 teaches the composition is useful for paint and cosmetics (See the abstract for example).

The references do not expressly teach the pigments taught in '724 be incorporated into the cosmetic composition of '056. The references do not expressly teach the herein recited particle size of pigments and glass beads and amount. The references do not expressly teach the glass beads to have a light transmission value of greater than 70%.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the pigments taught in '724 into the composition of '056. It would have been obvious to one of ordinary skill in the art at the time of invention to adjust the amount and particle size of the herein components. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the glass materials with light transmission of at least 85% in the cosmetics.

One of ordinary skill in the art would have been motivated to incorporate the pigments taught in '724 into the composition of '056 since incorporating the pigments taught in '724 into the paint composition of '056 would improve the hiding power and

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impact the glossy appearance of the colored composition of '056. Furthermore, one of ordinary skill in the art would have been motivated to adjust the particle size and amount of the herein claimed components since optimization of the result parameters is obvious as being within the purview of skilled artisan. The components of '056 are taught to have specific refractive index and therefore, employing the appropriate components with desirable light transmission properties such as the instant claimed would be seen to be obvious as being within the purview of skilled artisan.

### ***Response to Arguments***

Applicant's arguments filed March 25, 2009 averring the cited prior art teaching the composition as useful in paint and therefore not providing motivation to topical application to skin have been fully considered but they are not persuasive. The examiner notes that composition containing pigments, such as those taught in the cited prior art, are useful for impacting color on a surface. '724 teaches that the pigment composition can be used in both paint **and** cosmetics. What the examiner tries to point out is that composition containing pigments is useful in cosmetic and paint because it can impact coloring effect. Absent evidence showing the pigment composition as toxic or not suitable for topical use, one of skill in the art would have been motivated to employ the pigment composition of the cited prior art for cosmetic use (i.e., applying onto the skin).

Applicant's arguments filed March 25, 2009 averring the cited prior art's failure to teach aluminum flake have been considered and are moot. The examiner notes that

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the arguments to unclaimed limitation are considered moot. The claims only recite alumina flake.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (571) 272-0626. The examiner can normally be reached on Mon - Fri from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

San-ming Hui  
Primary Examiner  
Art Unit 1617

/San-ming Hui/  
Primary Examiner, Art Unit 1617